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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,869	01/03/2001	Richard Griffey	IBIS-0339	1982

7590

05/28/2004

COZEN O'CONNOR P.C.  
1900 MARKET STREET  
PHILADELPHIA, PA 19103-3508

EXAMINER
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BORIN, MICHAEL L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/753,869

**Applicant(s)**

GRIFFEY ET AL.

**Examiner**

Michael Borin

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12,27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Status of Claims***

1. Amendment filed 03/24/2004 us acknowledged. Claims 27-29 are added.  
Claims 12, 27-29 are pending.

### ***Claim Rejections - 35 USC § 112, second paragraph.***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As the base claim 12 requires that dissecting into fragments is based on the ease of synthesis, and dependent claims 27 restates the criteria for dissecting as based on commercial availability (which may not correlate to the ease of synthesis) claim 27 is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

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***Claim Rejections - 35 USC § 112, first paragraph.***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 29 introduces new matter as it addresses "formation of constituent fragments for which the reverse transformation is known" as the criteria for dissecting into fragments. Applicant points at paragraph bridging pages 4 and 5 as providing support for the amendment. However, said paragraph recites ease of synthesis and commercial availability as criteria for dissection, not the formation of constituent fragments for which the reverse transformation is known as required by claim 29.

***Claim Rejections - 35 USC § 102***

4. Claims 12, 27-19 are rejected under 35 U.S.C. 103(a) as obvious over Walters et al. The rejection is maintained for the reasons of record set forth for claim 16.

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Applicant's arguments have been fully considered but were not deemed persuasive for the following reasons.

Applicant argues that the "Chemically aware" builder does not present components of the virtual library as combinations of reagents and reactions, and has no basis on real world reactions. Examiner disagrees. The caption of Figure 1 addresses the method as examples of reactions. Further, the basis for the statement that Figure 1 is not based on "real world reactions" is unclear. Reactions depicted on the figure, e.g., of aldehydes and amines, or carbonylchlorides and amines, are trivial reactions well known to an organic chemist. The figure represents reagents that will readily interacting a "real world reactions".

Applicant further argues that in "Chemically aware builder" neither the compounds are dissected into fragments, nor there the fragments are added in synthetic rounds. However, every line in Figure 1 is seen by Examiner as representation of member of a compound library dissected into fragments and presented as a synthetic round leading to the target compound.

Further, applicant asserts that the CAESA software described in the reference uses "generalized synthetic transformations" whereas the claimed method "recites association with at least one reagent". Examiner does not see difference between these two highlighted definitions of "generalized synthetic transformations" and

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"association with at least one reagent". The former is the same generic as the latter. Further applicant asserts that the CAESA software does not provide adding of constituent fragments. The software would have had no use, had it not been adding fragments and assessing synthetic rounds leading to the target compound.

Finally, applicant provides argument based on distinction between "identifying" and "characterizing". First, in regard to "insight into the meaning of the term identifying", this definition is not in the claim language, and it can not be because the claims can not be drawn to identifying a "one to one link" because they recite "at least one" (i.e., a plurality" of reagents. Further, the dictionary definition of the term "characterization" for some reasons emphasizes "a description of qualities or peculiarities" as applied to places of interest. Examiner finds the first meaning "an instant of characterizing" to be more fitting to the instant situation in which a compound is characterized (or identified) by its fragments and reactions therebetween.

Further, other dictionaries offer similarly fitting definitions, e.g.,

"A special type of characterization translates an abstract property into a complete list of examples and models"

<http://mathworld.wolfram.com/Characterization.html>

or

"the application of techniques of examination by which characteristic properties of the constituent material of traded goods can be identified"

<http://www.webref.org/anthropology/c/characterization.htm>

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***Double Patenting***

5. Rejection of claim 12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8,9 of U. S. Patent No. 6253168 is maintained

Examiner maintains that it would be obvious to an artisan that information obtained by generating the database information as claimed in the reference will serve as a descriptor and identifier of a target compound.

As for restriction requirements in the instant case, the groups in the instant application are not identical to the recited claims in '168 patent.

***Conclusion.***

6. No claims are allowed

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

  
MICHAEL BORIN, PH.D.  
PRIMARY EXAMINER